

REMARKS

I. Introductory Comments

This amendment is being filed concurrently with a Request for Continued Examination and appropriate fee pursuant to 37 CFR 1.114. The amendment is a full and timely response to the Office Action dated April 3, 2007 (“Office Action”).

Applicants thank the Examiner for the courtesies extended during a telephone interview between the Examiner and Applicants’ representative of May 17, 2007. During the interview, the Examiner and Applicants’ representative discussed the evidentiary standard for Rule 131 Declarations as well as the extent to which a submission of additional evidence would overcome the concerns set forth in the Office Action.

In the Office Action, the Examiner maintained the rejections of: (1) claims 1-5, 8-12, 16, 21-24, and 30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0137945 (hereinafter “Takagi”) combined with U.S. Patent No. 6,529,602 (hereinafter “Walker”) and further in view of U.S. Patent Application Publication No. 2003/0032447 (hereinafter “Bulthuis”); (2) claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over the combination of Takagi, Walker, and Bulthuis, and further in view of U.S. Patent Application Publication No. 2002/0160751 (hereinafter “Sun”); (3) claims 7, 14, 18, 26, and 27 under 35 U.S.C. §103(a) as being unpatentable over Takagi combined with Walker, Bulthuis, and Sun and further in view of U.S. Patent No. 6,072,860 (hereinafter “Kek”); and (4) claims 19, 20, 28, and 29 under 35 U.S.C. §103(a) as being unpatentable over Takagi combined with Walker, Bulthuis, Sun, and Kek, and further in view of U.S. Patent Application Publication No. 2003/0012346 (hereinafter “Langhart”).

No amendments have been made to the claims in this paper. Therefore, claims 1-14, 16, 18-24, and 26-30 remain pending in the application.

In the Office Action, the Examiner found Applicants’ Second Rule 131 Declaration filed on February 8, 2007 (“Second Rule 131 Declaration”) to be ineffective. According to the Office Action, “[t]he exhibit submitted on 2/8/7 under 37 CFR 1.131 is insufficient to establish a conception of the invention prior to the effective date of the Bulthuis, Sun and Langhard references” and “[t]he evidence submitted is also insufficient to establish due diligence.” Office Action, pages 2 and 4, emphasis added.

Applicants respectfully disagree with the finding of the Second Rule 131 Declaration to

be ineffective to establish conception and diligence. In particular, the analysis set forth in the Office Action improperly ignores the facts sworn to in the Declaration and requires *Exhibit A* on its own to provide evidence of conception and diligence. Such a standard is incorrect.

The MPEP unequivocally states that “when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and ‘notes.’ An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).” MPEP §715.07(I), emphasis added. Therefore, the Examiner must not look to an exhibit alone but to the totality of the evidence. Moreover, it is not necessary for an accompanying exhibit to support all claim elements.

In taking the position set forth in the Office Action, the Examiner is confusing the examination of this application with an interference proceeding. This is not an interference proceeding. The MPEP states that “in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).” MPEP §715.07, emphasis added. Thus, Applicants are not required to submit the type of evidence described in the Office Action when, outside of an interference, Applicants are merely establishing a date of invention that antedates cited prior art. Accordingly, Applicants are allowed to stand on statements made in the Second Rule 131 Declaration and do not need to submit corroborating evidence for each and every claim element.

Nevertheless, in view of the aforementioned telephone interview with the Examiner and in order to further prosecution, Applicants have submitted together with this amendment a third declaration under 37 CFR §1.131 (“Third Rule 131 Declaration”) together with *Exhibits A, B, and C*. For the following reasons, Applicants respectfully submit that the Third Rule 131 Declaration and accompanying exhibits overcome the concerns set forth in the Office Action and are effective to antedate the Bulthius, Sun, and Langhart references. Accordingly, Applicants respectfully request favorable reconsideration of the presently pending claims. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the

patentability of claims not explicitly addressed herein, in future papers.

II. Effectiveness of Applicants' Third Rule 131 Declaration

A. Effective to establish conception

According to the Office Action, *Exhibit A* does not disclose “that the plurality of data management functions includes a function for translating the two-way conversion data stored in the remote storage device,” “that the secondary device interface is a wireless interface that allows data transfer between the memory and the secondary device,” or that “the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language.” Office Action, pages 2-3.

Inasmuch as Applicants are allowed to rely on the statements made in the Third Rule 131 Declaration to establish conception, the Third Rule 131 Declaration provides sufficient evidence that Applicants conceived of the claimed invention before February 27, 2001. In the Third Rule 131 Declaration, Applicants state with particularity that they conceived of the elements recited in the claims, including the specific claim elements questioned by the Examiner in the Office Action. Specifically, Applicants declare in the Third Rule 131 Declaration:

More specifically, prior to February 27, 2001 we conceived of:

...the plurality of data management functions including functions for editing, translating, searching, linking, downloading, editing, playing back, converting, sending, archiving, and deleting the two-way conversation data stored in the remote storage device;

...wherein the secondary device interface includes an attachment that physically connects the memory to the secondary device or is a wireless interface that allows data transfer between the memory and the secondary device;

...wherein the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language....

See Applicants' Third Rule 131 Declaration at paragraphs 2(a)(iv), 2(a)(v), and 2(b)(xi), emphasis added. As mentioned above, the MPEP is clear that this evidence, and any other evidence set forth in the Third Rule 131 Declaration, does not require corroborating support. Therefore, the Third Rule 131 Declaration provides more than sufficient evidence that the Applicants conceived of the claimed invention prior to February 27, 2001.

Nevertheless, in addition to *Exhibit A*, Applicants have submitted additional corroborating evidence in order to further prosecution and address the concerns set forth in the Office Action. *Exhibit A* is a redacted portion of an Invention Disclosure that was prepared and executed by the inventors and witnessed before February 27, 2001. The first page of the exhibit shows the initial portion of the Invention Record while the third page shows the inventor signatures and the date on which the inventors executed the Invention Record, namely July 28, 2000. Further, the third page also shows the signatures of two witnesses and the respective dates of execution, specifically August 1, 2000 and August 2, 2000. The fourth page has the written initials of the inventors and witnesses and the respective dates of execution, which is the same as for third page. Exhibit A provides further evidence that the inventors conceived of the claimed invention prior to February 27, 2001.

Exhibit B is a copy of text document that was prepared by legal counsel for the original assignee of the present application. *Exhibit B* is a summation of a telephone conversation that Applicants had with the same legal counsel on January 30, 2001. As such, *Exhibit B* provides further evidence that Applicants conceived of the claimed invention prior to February 27, 2001, including the specific claim elements questioned in the Office Action. For example, *Exhibit B* describes translating a recorded conversation from French to another language. *Exhibit B* also mentions a “text speech system” in the context of translating from one language to another. As another example, *Exhibit B* describes an attachment having a wireless networking capability that allows a recorded conversation to be moved to a secondary device. These examples in *Exhibit B* provide further evidence that Applicants conceived of the claimed invention prior to February 27, 2001.

In addition, *Exhibit C* is a copy of a document audit trail history descriptive of the dates and times when the electronic file containing the summation of the telephone conversation represented in part by *Exhibit B* was created, saved, and accessed. As shown in *Exhibit C*, the electronic file from which the contents of *Exhibit B* were obtained was created and modified only during a period beginning January 30, 2001 and ending February 2, 2001. More specifically, the document was stored in F:\docs\65632\41\misc under document filename r0103994.doc. “65632” represents the client number corresponding to client identifier associated with the present client by outside counsel. “41” corresponds to the matter number for the present application as used by outside counsel. “misc” corresponds to a miscellaneous document stored

within the document management system of outside counsel for the matter number associated with the present application. As shown in reverse chronological order by the bottom of the exhibit, the document was first created and saved on January 30, 2001 at 6:52pm. It was last saved on January 2, 2001 at 6:35pm. It was then next opened, but not saved on January 8, 2001 at 3:26pm. Thus, *Exhibit C* provides further evidence that Applicants conceived of the claimed invention prior to February 27, 2001.

For at least these reasons, Applicants respectfully submit that the Third Rule 131 Declaration and accompanying *Exhibits A, B, and C* provide more than sufficient evidence that Applicants conceived of the claimed invention prior to February 27, 2001.

B. Effective to establish diligence

According to the Office Action:

Although Applicant provided multiple statements regarding the issue of diligence on pages 10 and 11 of the response filed 2/8/7, Applicant does not submit any evidence to support these statements. For instance, on page 10 of the response, Applicant states that activities of the legal counsel includes [sic] at least one telephone conference on January 30, 2001. However, Applicant does not provide any evidence of the alleged telephone call.

Again, the Examiner has relied upon an improper evidentiary by requiring corroborating evidence and not allowing Applicants to rely on statements made in the Second Rule 131 Declaration. Based on the proper evidentiary standard for antedating a reference, Applicants respectfully submit that their Third Rule 131 Declaration provides sufficient evidence to establish due diligence from just prior to Feb. 27, 2001 until the filing of the present patent application. In the Third Rule 131 Declaration, at paragraph 6, Applicants declare:

We worked toward reducing the claimed invention to practice from prior to February 27, 2001 until a filing of the present patent application with the U.S. Patent and Trademark Office by, *inter alia*, working with legal counsel for the original assignee of the present application in preparing and filing the patent application, including, at least, (1) participating in one or more telephone conversations with legal counsel with regards to preparation of the patent application (2) reviewing and providing comments on several draft specifications for the patent application during that time period, (3) reviewing and providing comments on several draft sets of drawings for the patent application during that time period, (4) reviewing a final draft of the specification and a final draft of the drawings towards the end of that time period in anticipation of, and with the expectation of, executing formal papers for the filing of the patent application,

and (5) executing those formal papers and returning them to the legal counsel towards, or at the end of that time period. Upon information and belief, activities of legal counsel for the original assignee of the present application during this period included:

- a. at least one telephone conference call between us and outside legal counsel for the original assignee of the present application on January 30, 2001;
- b. preparation and completion of informal draft drawings for the patent application in March 2001;
- c. preparation and completion of formal draft drawings for the patent application in April 2001;
- d. revision of the formal draft drawings for the patent application in April 2001;
- e. preparation of a draft specification for the patent application in March and April 2001;
- f. submission of the draft specification and formal drawings to in-house legal counsel for the original assignee of the present application on April 26, 2001;
- g. revision of the formal drawings for the patent application in July 2001;
- h. revision of the specification for the patent application in July 2001;
- i. submission of the revised specification and formal drawings to in-house legal counsel for the original assignee of the present application on August 3, 2001; and
- j. filing of the patent application with the U.S. Patent & Trademark Office on August 17, 2001.

This statement of facts is more than sufficient to show due diligence during the period of time at issue (i.e., from prior to February 27, 2001 until the filing of the application on August 3, 2001). "The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor." MPEP §2138.06. It has been held that an attorney working on a reasonable number of matters in chronological order until preparing and filing a patent application satisfies the required diligence. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986). See also, MPEP §2138.06. Again, as presented above, corroborating evidence is not required to show diligence in a declaration under 37 CFR §1.131.

Nevertheless, to further prosecution and address the specific concerns set forth in the Office Action, Applicants have provided further evidence of diligence. In particular, ***Exhibits B and C*** corroborate Applicants' statement in the Third Rule 131 Declaration that they, "from prior to February 27, 2001 until a filing of the present patent application with the U.S. Patent and Trademark Office," "work[ed] with legal counsel for the original assignee of the present application in preparing and filing the patent application, including, at least, (1) participating in one or more telephone conversations with legal counsel with regards to preparation of the patent application...." Accordingly, ***Exhibits B and C*** provide further evidence of Applicants' diligence and particularly of the occurrence of at least one telephone call between Applicants and legal counsel for the original assignee of the present application on January 30, 2001.

For at least these reasons, the Third Rule 131 Declaration together with ***Exhibits A, B, and C*** are effective to establish diligence during the relevant period.

III. Rejection of Claims 1-5, 8-12, 16, 21-24, and 30 under 35 U.S.C. §103(a) as being unpatentable over Takagi, Walker, and Bulthuis

As described above, the Third Rule 131 Declaration and accompanying ***Exhibits A, B, and C*** provide more than sufficient evidence that Mr. Elman and Mr. Hefter conceived of the claimed invention prior to February 27, 2001 and diligently reduced the claimed invention to practice from prior to February 27, 2001 until the filing of the present application on August 17, 2001.

The Bulthuis reference has a filing date of August 10, 2001, a mere one week earlier than the filing date of the present Application. Therefore, based on the Third Rule 131 Declaration, ***Exhibits A, B, and C*** and the remarks provided above, Applicants have antedated the Bulthuis reference under 37 CFR §1.131. Accordingly, the Bulthuis reference does not qualify as prior art against the application.

Without the Bulthuis reference, the Office Action fails to establish a *prima facie* case of obviousness against claims 1-5, 8-12, 16, 21-24, and 30, especially in view of the Office Action expressly stating that "the combination of Takagi and Walker fails to explain the plurality of data management functions includes a function for translating the two-way conversation data stored in the remote storage device." Office Action, page 4. Independent claims 1, 8, and 22 include recitations directed to a plurality of data management functions including functions for editing

and translating the two-way conversation data. Therefore, the rejection of claims 1-5, 8-12, 16, 21-24, and 30 should be withdrawn.

IV. Rejection of Claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over Takagi, Walker, Bulthuis, and Sun

Sun does not cure, and the Examiner does not allege that Sun cures, the above-described deficiencies of Takagi and Walker. Therefore, without the Bulthuis reference, the Office Action also fails to establish a *prima facie* case of obviousness against claims 6 and 13, and the rejection of these claims should be withdrawn at least because of their dependencies from independent claims 1 and 8, respectively.

Moreover, the Sun reference has a filing date of April 26, 2001. Therefore, based on the Third Rule 131 Declaration, *Exhibits A, B, and C*, and the remarks provided above, Applicants have antedated the Sun reference under 37 CFR §1.131. Accordingly, the Sun reference does not qualify as prior art against the application.

Without the Sun reference, the Office Action fails to establish a *prima facie* case of obviousness against claims 6 and 13, especially in view of the Office Action expressly stating that “the combination of Takagi, Walker and Bulthuis fails to show the secondary device interface is a wireless interface that allows data transfer between the memory and the secondary device.” Office Action, page 9. Claims 6 and 13 include recitations of “wherein the secondary device interface is a wireless interface that allows data transfer between the memory and the secondary device.” Therefore, the rejection of claims 6 and 13 should be withdrawn.

V. Rejection of Claims 7, 14, 18, 26, and 27 under 35 U.S.C. §103(a) as being unpatentable over Takagi, Walker, Bulthuis, Sun, and Kek

Kek does not cure, and the Examiner does not allege that Kek cures, the above-described deficiencies of Takagi and Walker. Therefore, the rejection of claims 7, 14, 18, 26, and 27 should be withdrawn at least because these claims depend from independent claim 1, 8, or 22.

VI. Rejection of Claims 19, 20, 28, and 29 under 35 U.S.C. §103(a) as being unpatentable over Takagi, Walker, Bulthuis, Sun, Kek, and Langhart

Langhart does not cure the above-described deficiencies of Takagi and Walker.

Therefore, the rejection of claims 19, 20, 28, and 29 should be withdrawn at least because these claims depend from independent claim 8 or 22.

Moreover, the earliest possible priority date for the Langhart reference is February 27, 2001. Therefore, based on the Third Rule 131 Declaration, *Exhibits A, B, and C*, and the remarks provided above, Applicants have antedated the Langhart reference under 37 CFR §1.131. Accordingly, the Langhart reference does not qualify as prior art against the application.

Without the Langhart reference, the Office Action fails to establish a *prima facie* case of obviousness against claims 19, 20, 28, and 29, especially in view of the Office Action expressly stating that “the primary teachings fail to indicate the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language” and that “the primary teachings fail to indicate the translating function is conducted by an audio translation service that converts at least a portion of the audio data from a first language to a second language.” Office Action, pages 12 and 13. Claims 19 and 28 are directed to the translating function being conducted by a text translation service that converts at least a portion of the text data from a first language to a second language. Claims 20 and 29 are directed to the translating function being conducted by an audio translation service that translates at least a portion of the audio data from a first language to a second language. Therefore, the rejection of claims 19, 20, 28, and 29 should be withdrawn.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-00041. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: June 18, 2007

Respectfully submitted,

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